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6 **IN THE UNITED STATES DISTRICT COURT**
7 **FOR THE DISTRICT OF ARIZONA**
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9 Parsons Xtreme Golf LLC,

10 Plaintiff,

11 v.

12 Taylor Made Golf Company Incorporated,

13 Defendant.
14

No. CV-17-03125-PHX-JJT

ORDER

15 At issue is Defendant/Counterclaimant Taylor Made Golf Company Inc.’s
16 (“Taylor Made”) Motion for Issuance of Letter Rogatory for International Judicial
17 Assistance (Doc. 102, Mot.), to which Plaintiff/Counter-Defendant Parsons Xtreme Golf
18 LLC (“PXG”) filed a Response (Doc. 112, Resp.), and Taylor Made filed a Reply (Doc.
19 114, Reply). No party requested oral argument, and the Court finds the Motion
20 appropriate for resolution on the briefs. *See* LRCiv 7.2(f). The Court will grant Taylor
21 Made’s Motion.

22 **I. BACKGROUND**

23 Both parties are designers, manufacturers, and sellers of golf clubs used
24 worldwide by professional and amateur golfers alike. PXG filed this lawsuit in October
25 2017 seeking both a temporary restraining order and preliminary injunction against
26 Taylor Made to block the release of Taylor Made’s latest set of irons, the P790. In its
27 Second Amended Complaint, PXG alleges that the P790 Irons infringe upon 11 separate
28 PXG patents, which PXG contends were lawfully issued by the United States Patent and

1 Trademark Office (“USPTO”) and used in PXG’s own irons, the 0311. (*See* Doc. 76, 2d
2 Am. Compl. ¶¶ 42–151.) Taylor Made subsequently filed an answer and its own set of
3 counterclaims, which seek declaratory judgments that each patent named in PXG’s
4 Complaint is invalid and that the P790 Irons do not infringe any PXG patent. (Doc. 86,
5 2d Am. Countercl. ¶¶ 29–188) Taylor Made also alleges, to various degrees, that PXG’s
6 Irons, Drivers, Fairway Woods, and Hybrid infringe upon several of Taylor Made’s
7 patents. (2d Am. Countercl. ¶¶ 189–248.)

8 Taylor Made now seeks additional discovery from a non-party manufacturer of
9 golf clubs—the Yamaha Corporation—which is based in Japan. As discussed in its
10 Motion, Taylor Made wishes to authenticate a club purported to be Yamaha’s inpresX
11 425V Iron (the “425V Iron”) and accompanying Yamaha Spring 2007 golf catalog. (Mot.
12 at 4), which arguably render PXG’s patents invalid. Prior to seeking relief from this
13 Court, Taylor Made contacted representatives from Yamaha Corporation of America,
14 who in turn forwarded Taylor Made’s requests to Yamaha’s representatives in Japan.
15 (*See* Doc. 102-1, Mot. Ex. C., Email from N. Kosugi to L. Tran.) Yamaha’s
16 representatives, however, indicated that the company would comply only through an
17 inquiry properly submitted through the United States and Japanese courts.

18 Accordingly, Taylor Made now moves for the Court to issue a letter rogatory to
19 the courts of Japan. In particular, Taylor Made desires to obtain oral testimony from a
20 representative from Yamaha in response to a list of written questions provided by Taylor
21 Made. (Doc. 102-1, Mot. Ex. 1 at 2–4.)

22 **II. LEGAL STANDARD**

23 “A letter rogatory is a formal written request sent by a court to a foreign court
24 asking that the testimony of a witness residing within that foreign court’s jurisdiction be
25 taken pursuant to the direction of that foreign court . . . for use in a pending action.”
26 *Barnes & Noble, Inc. v. LSI Corp.*, 2013 WL 812331, at *1 (N.D. Cal. Mar. 5 2013)
27 (citing *Marroquin-Manriquez v. INS*, 699 F.2d 129 (3d Cir. 1983)); 8A Charles Alan
28 Wright & Arthur R. Miller, *Federal Practice and Procedure* § 2063 (3d ed. 2018)

1 (hereinafter, “Wright & Miller”). Federal Rule of Civil Procedure 28(b)(1) permits
2 litigants to take a deposition in a foreign country “under a letter of request, whether or not
3 captioned a ‘letter rogatory.’” A court may issue such a letter “without a showing that
4 taking the deposition in another manner is impractical or inconvenient.” Fed. R. Civ. P.
5 28(2)(B).

6 A district court has inherent authority to issue a letter rogatory. *United States v.*
7 *Staples*, 256 F.2d 290, 292 (9th Cir. 1958); Wright & Miller § 2063. Whether to issue
8 such a letter is within a court’s discretion; however, a court should neither “weigh the
9 evidence sought from the discovery request nor . . . attempt to predict whether that
10 evidence will actually be obtained.” *Barnes & Noble*, 2013 WL 812331, at *2. Generally,
11 a court should grant such a request absent a showing by the opposing party demonstrating
12 good cause to deny the motion. *See, e.g., MicroTechnologies, LLC v. Autonomy, Inc.*,
13 2016 WL 1273266, at *1 (N.D. Cal. Mar. 14, 2016); *Evanston Ins. Co. v. OEA, Inc.*, 2006
14 WL 1652315, at *2 (E.D. Cal June 13, 2006). The decision whether to permit a
15 deposition pursuant to Rule 28 must be guided by the scope of discovery permitted under
16 Rule 26. *See B & L Drillings Elecs. v. Totco*, 87 F.R.D. 543, 545 (W.D. Okla. 1978).

17 **III. ANALYSIS**

18 PXG offers two primary arguments in opposition to Taylor Made’s Motion: (1)
19 that that Taylor Made has not exhausted other means to obtain the desired discovery and
20 (2) that the burden of Taylor Made’s request outweighs any benefit of the proposed
21 discovery. Each of PXG’s arguments, however, lands well short of the green.

22 **A. Whether Taylor Made Must Exhaust All Other Means Prior to** 23 **Obtaining the Desired Discovery**

24 PXG argues that good cause exists to deny Taylor Made’s Motion because Taylor
25 Made fails to demonstrate that it exhausted all other means for obtaining the information
26 it now seeks. (Resp. at 8–9.) In particular, PXG cites to both *B & L Drilling Electronics*
27 *v. Totco*, 87 F.R.D. 543 (W.D. Okla. 1978) and *Del Estado v. Navistar International*
28 *Transportation Corp*, 1996 WL 745313 (N.D. Ill. 1996) in support of this proposition.

1 Yet, neither supports the arguments made by PXG, and in fact, only serve to bolster
2 Taylor Made's Motion. Indeed, PXG is correct that the court in *B & L Drilling*
3 conditioned its issuance of a letter rogatory on the propounding party first seeking
4 discovery by a less burdensome means; however, PXG fails to recognize that the less
5 burdensome means permitted by that court—a Rule 31 deposition—is the precise means
6 of discovery sought by Taylor Made in this case. *See B & L Drilling Elecs.*, 87 F.R.D. at
7 545. Similarly, although the *Del Estado* Court sequenced discovery such that
8 international discovery proceeded following domestic efforts, the Court explicitly
9 exempted discovery through letters rogatory and depositions from that sequencing. *Del*
10 *Estado*, 199 WL 745313, at *5 (“[I]nternational discovery (other than Letters Rogatory
11 and deposition) will proceed after completion of fact written discovery in the United
12 States.”) Moreover, the imposition of an exhaustion requirement in such a case would
13 appear to stand in opposition to the plain language of Rule 28, which permits taking a
14 deposition by letter rogatory “without a showing that taking the deposition in another
15 manner is impractical or inconvenient.” *See Fed. R. Civ. P. 28(2)(B)*. The Court thus
16 rejects PXG's argument that Taylor Made must exhaust all other possible means of
17 obtaining the desired information prior to seeking a letter rogatory from this Court.

18 **B. Whether the Burden of Taylor Made's Request Outweighs the Benefit**
19 **of the Information Sought**

20 PXG offers two remaining arguments which the Court considers in conjunction.
21 First, PXG argues that Taylor Made's request imposes a tremendous burden on each
22 party involved. (Resp. at 3–5.) Second, PXG contends that Taylor Made fails to
23 demonstrate any likely benefit from the discovery sought. (Resp. at 5–7.) Thus, PXG
24 concludes that the Court should prohibit the discovery pursuant to Rule 26. (Resp. at 8.

25 At the outset, the Court does acknowledge that Taylor Made's request may
26 necessitate additional expenses for PXG, such as traveling to Japan and hiring local
27 counsel. (*See Resp. at 4.*) The Court, however, rejects the remainder of PXG's conclusory
28 argument on this point. In its Response, PXG largely argues that the issuance of a letter

1 rogatory places a heavy burden on the parties because of Yamaha’s refusal to testify.
2 PXG, however, points to no authority even suggesting that the “willingness” of the
3 proposed deponent is a factor that a court may properly consider when determining
4 whether to issue a letter rogatory. As PXG rightly points out, a willing party obviates the
5 need for a letter rogatory. (Resp. at 4.) Thus, the existence of the letter rogatory
6 mechanism necessarily anticipates the existence of an unwilling deponent. It strikes the
7 Court as odd then to weigh the fact necessitating the use of a letter rogatory mechanism
8 against using that very mechanism.

9 Even if Taylor Made’s request creates some burden for PXG, the Court cannot
10 conclude that the information sought by Taylor Made is not material and necessary to
11 Taylor Made’s defenses and counterclaims. The Court thus rejects PXG’s argument that
12 the proposed questions “will not elicit information necessary to satisfy the legal
13 requirements for demonstrating that [the 425V Irons] are prior art.” (Resp. at 6.) Taylor
14 Made need not demonstrate that the evidence its seeks to obtain will—own its own—
15 establish that the 2007 Yamaha catalog and 425V Irons are prior art sufficient to
16 invalidate PXG’s patents, but only that the information sought is relevant to that
17 particular defense. The Court thus fails to see how the authenticity of the 425V Irons and
18 the 2007 Spring catalogue and the initial release dates of each would not be relevant to
19 Taylor Made’s contention that the product renders PXG’s patents invalid. *See* 35 U.S.C.
20 § 102(a)(1) (“A person shall be entitled to a patent unless . . . the claimed invention was
21 patented, described in a printed publication, or in public use, on sale, or otherwise
22 available to the public *before the effective filing date* of the claimed invention”
23 (emphasis added)).

24 Thus, the burden of the proposed discovery does not outweigh its likely benefit,
25 particularly when factoring in the importance of the issues at stake and the amount in
26 controversy in this matter. The Court will thus grant Taylor Made’s Motion.

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